

REMARKS

Status of the Claims

Claims 17-29 and 33 are pending in this application. No claims have been canceled or added. Claim 17 has been amended to recite that the amount of dimerdiol ester is 0.1 to 50% by weight of the cosmetic or external agent. Support for this amendment is found at page 10, line 9 of the specification. Claim 33 has been amended to recite that the dimerdiol is produced by hydrogenating a dimer acid obtained by dimerization of an unsaturated fatty acid having 11 to 22 carbon atoms. Support for this amendment is found at page 3, last line to page 4, line 3. No new matter has been added by the above claim amendments.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 17 and 33 as indefinite. Claim 17 is rejected because it fails to recite what the weight percent is based on. Applicants amend claim 17 to recite that the weight percent is based on the entire cosmetic or external agent. Claim 33 is rejected because of the Markush group and a typographical error that implies that a range within a range is claimed. Applicants amend "salicyclic" to "salicylic". Applicants also

amend the claims to particularly define the members of the Markush group. As the above claim amendments overcome these rejections, Applicants respectfully request that the rejection be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Ansmann in view of Akrongold

The Examiner rejects claims 17-20, 22-29 and 33 as obvious over Ansmann USP 5,795,978 (Ansmann '978) in view of Akrongold USP 3,846,550 (Akrongold '550). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Ansmann '978 discloses emulsifiers, which are suitable for production of emulsions of the oil in water type. Ansmann '978 merely mentions that esters of linear and/or branched fatty acids with polyhydric alcohols, such as "dimer diol" or "trimer diol" are suitable oils.

Applicants submit that "dimer diol" and "dimerdiol" and "trimerdiol" and "trimer diol" discussed at column 3, lines 14-17 and column 4, line 49 of Ansmann '978 are different compounds from "dimerdiol" as used in the present invention. In fact, a "trimer diol" is meaningless within the meaning of the present invention. According to the present invention, a "trimer diol" would be

interpreted as "trimer triol". It appears, however, that dimer diol as used in Ansmann is represented by the formula HO-Ar-O-Ar-OH, wherein Ar is ethylene. It also appears that trimer diol is represented by the formula HO-Ar-O-Ar-O-Ar-H, wherein Ar is ethylene. Thus, while the "dimer diol" and "trimer diol" as used in Ansmann are both known for uses in cosmetics, neither is a "dimerdiol" of the present invention.

In fact, what Ansmann '978 fairly teaches is that neither "dimer diol" nor "trimer diol" is identical to the dimerdiol as recited in the present invention.

Moreover, Ansmann '978 fails to disclose the specific compounds of esters of linear and/or branched fatty acids with polyhydric alcohols, such as esters of dimer diol or trimer diol. Ansmann '978 clearly fails to disclose esters of dimerdiols.

Accordingly, it is clear that Ansmann '978 does not disclose or suggest a dimerdiol as recited in the present invention.

Akrongold '550 discloses a cosmetic skin powder containing urea, an oil phase and an inorganic pigment. The oil is disclosed as being acids and alcohols containing 5 to 52 carbon atoms. Specifically disclosed oils are esters of fatty acids as a genus, and limited numbers of fatty acid esters including isopropyl

myristate and hexadecyl stearate. These specific examples are outside the scope of the esters of the present invention. Moreover, since the disclosure of Akrongold '550 fails to disclose or suggest polyhydric alcohols, it also fails to teach or suggest to those of ordinary skill in the art the dimerdiol esters of the present invention.

Applicants submit that the combination of Ansmann '978 and Akrongold '550 do not disclose or suggest all the limitations of the present invention. As such, no *prima facie* case of obviousness has been established as one of ordinary skill in the art would not be able to arrive at the present invention from the combination of references.

Applicants also submit that the Examiner is using impermissible hindsight to reconstruct the present invention. The Examiner merely relies on Applicants' own teachings to form the obviousness rejection. Neither reference suggests combining the references to arrive at the present invention. Such hindsight reconstruction is impermissible according to MPEP 2141 and In re Deminski, 796 F.2d 436, 443 230 USPQ 313, 316 (Fed. Cir. 1986).

Ansmann in view of Akrongold and Bernhardt

The Examiner also rejects claim 21 as obvious over Ansmann '978 in view of Akrongold '550 and further in view of Bernhardt USP 4,788,054 (Bernhardt '054). Applicants traverse the rejection and respectfully request the withdrawal thereof.

In traversing this rejection, Applicants rely on the arguments above regarding the failure of Ansmann '978 and Akrongold '550 to disclose or suggest all the elements of the present invention and the Examiner's use of impermissible hindsight.

Moreover, Bernhardt '054 discloses a sunscreen containing cosmetic oil, such as fatty acid esters. Bernhardt '054 discloses at column 7, lines 4-12 esters that are esters of fatty acids with at least one hydroxyl group containing compound 1 mono- di- and tri- alkanols, each containing less than 7 carbon atoms per molecule, such as mixed glycerides, vegetable oils, isopropyl palmitate and isopropylmyristate. However, these esters are also outside the scope of the esters of the present invention. Thus, while Bernhardt et al. may also teach rosin, its disclosure when combined with the remaining cited art references does not cure the above noted deficiencies of Ansmann et al. and Akrongold et al. As such, one of ordinary skill in the art would not be able to arrive

at the present invention from the combination of references. Thus, the rejection should be withdrawn.

**Addressing the Examiner's Note**

Applicants add that in claim 25 the dimerdiol ester is defined by the process for producing the same. Because of the nature of the dimerdiol produced from the unsaturated fatty acid, the composition of the dimerdiol is not always simply defined. Thus, the most appropriate way to recite the subject matter of the invention is by the process in which the product is made by the alcohol.

**Conclusion**

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

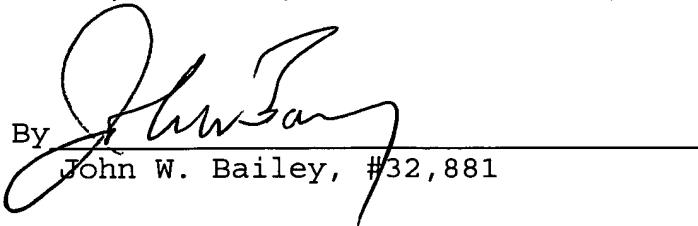
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present

application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
John W. Bailey, #32,881

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

JWB/KJR/bsh

Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows:

17. (Twice Amended) The cosmetic or an external agent according to claim 29, wherein the amount of the dimerdiol ester is 0.1-50% by weight in the cosmetic or external agent.

33. (Amended) A cosmetic or an external agent comprising a dimerdiol ester of a monocarboxylic acid selected from the group consisting of:

- i) linear saturated acids having 4 to 34 carbon atoms,
- ii) branched fatty acids having 4 to 34 carbon atoms,
- iii) linear unsaturated acids having 10 to 32 carbon atoms,
- iv) hydroxy acids having 4 to 34 carbon atoms and
- v) cyclic acids having 4 to 34 carbon atoms, selected from the group consisting of cyclohexanoic acid, hydrogenated rosin, rosin, abietic acid, hydrogenated abietic acid, benzoic acid, p-oxybenzoic acid, p-aminobenzoic acid, salicylic [salicyclic] acid, gallic acid, pyrrolidonecarboxylic acid and nicotinic acid; and/or a dimerdiol ester of a dicarboxylic acid, and

wherein said dimerdiol is a dimerdiol produced by  
hydrogenating a dimer acid obtained by dimerization of an  
unsaturated fatty acid having 11 to 22 carbon atoms.